

PATENT
10/811,033
Docket 011/007c

REMARKS

This paper is responsive to the Office Action dated October 5, 2005, which is the second action on the merits of the application. The Action has been made final.

The undersigned is grateful to the Examiner for his careful review and consideration of this application. Claims 1-25 are pending, and stand variously rejected. This Response makes no amendments to the claims.

Further consideration and allowance of the application is respectfully requested.

New matter rejection:

The claims stand rejected as being new matter.

However, it is well established in the relevant case law that disclosure in an originally filed claim satisfies the written description requirement, and does not add new matter. *In re Gardner*, 178 USPQ 149 (CCPA 1973); *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227 (Fed. Cir. 2000). See also MPEP § 608.01(I), and MPEP § 608.04.

The claims pending in this application have not been substantively amended since filing. The Office Action states that the pending claims are not original claims, because this application is a continuation of previously issued patents. *But this does not mean that the claims are new matter to this particular patent application.* Should the Office wish to make a rejection based on how the original claims of this application relate to previous applications, then the rejection should be made under a separate heading in a new non-final Office Action.

Withdrawal of this rejection is respectfully requested.

Written description:

The claims also stand rejected under the written description requirement of 35 USC § 112 ¶ 1 as not being described in the application as filed. Citing *University of Rochester v. G. D. Searle & Co.*, 358 F.3d 916 (Fed. Cir. 2004), the Office Action maintains that the inhibitor compound needs to be defined by structure or other physical characteristics.

Applicants respectfully disagree. The claims here are distinguishable from situation in the cited case. A copy of the claims from the Rochester parent accompany this Response for the convenience of the Examiner. The Rochester claims cover a use of a compound, and therefore the Court found that the specification needed to provide the compound to the reader in order to use it in

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the manner claimed. In contrast, the claims in the present application cover the identification and production of a compound. Thus, the user will have the telomerase inhibitor compound in hand as a result of steps a) to d) of claim 1, before undertaking to produce more of it in step e).

There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. Consequently, rejection of an original claim for lack of written description should be rare.

— MPEP § 2163.03, citing *In re Wertheim*, 191 USPQ 90, 96 (CCPA 1976)

Furthermore, the first Office Action in this application mailed April 26, 2005, indicated that the subject matter claimed here is common to claims 18-20 of priority application 09/717,828 (now U.S. Patent 6,517,834), and claims 1-25 of priority application 10/330,872 (now U.S. Patent 6,787,133).

The subject matter claimed in the instant application is *fully disclosed* in the patent and is covered by the patent since the patents and the application are claiming common subject matter, as follows: A method for assessing a regulator of telomerase, which uses the obvious variation of method steps of measuring the telomerase activity in the presence of a regulator, where the regulator is a telomerase inhibitor or activator, *and having identified the regulator producing the same.* [italics added]

The Office cannot have it both ways. If the subject matter claimed here was fully disclosed in the priority applications, then it is also fully disclosed by the present specification — which means that the written description requirement of 35 USC § 112 ¶ 1 is satisfied.

In fact, Applicant has never disputed the assertion quoted above. The Office has not indicated that it has changed its opinion on this matter. If it has done so, then applicant respectfully requests a new Office Action, so that the written description rejection can be addressed in the new context.

Otherwise, applicant requests that this rejection be withdrawn.

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Request for Interview

Applicant respectfully requests that all outstanding rejections be reconsidered and withdrawn. The application is believed to be in condition for allowance, and a prompt Notice of Allowance is requested.

In the event that the Examiner determines that there are other matters to be addressed, applicant hereby requests a further interview by telephone.

Fees Due

No fee is believed necessary for entry or consideration of this paper. However, should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Michael Schiff", is written over a large, loopy circular mark.

J. Michael Schiff
Registration No. 40,253

GERON CORPORATION
230 Constitution Drive
Menlo Park, CA 94025
Telephone: (650) 473-7715
Fax: (650) 473-8654

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GERON CORPORATION
230 Constitution Drive
Menlo Park, CA 94025
Phone: (650) 473-7700
Fax: (650) 473-8654

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